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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF APPEALS

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| Appellant: | Marius HAURI et al. |) | |
| Serial No: | 10/665,514 |) | Attorney Docket: 0100/0165 |
| Filed: | September 22, 2003 |) | |
| For: | SAFETY NEEDLE ASSEMBLY AND METHOD FOR MAKING THE SAME |) | Appeal No: |

APPELLANT'S SUBSTITUTE BRIEF ON EX PARTE APPEAL

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is a substitute Appeal Brief filed in response to the Examiner's Answer dated July 7, 2008 and replaces the original Appeal Brief in light of the Examiner's "new" ground of rejection. This Brief also acts as the Reply Brief by addressing the new points of arguments raised in the Examiner's Answer.

This Brief maintains the appeal of the final rejection of pending claims 1, 2, 4-6, 8-11, 13-21, 23-25 and 27-28 of the above-identified application.

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REAL PARTY IN INTEREST

The real party in interest is Smiths Medical ASD, Inc.

The instant invention was originally assigned by the inventors to Portex, Inc. per an assignment recorded September 22, 2003 in the Assignment Branch of the U.S. PTO. The name of Portex, Inc. was subsequently changed to Smiths Medical ASD, Inc. The change of name was submitted to the U.S. PTO on March 9, 2004.

RELATED APPEALS AND INTERFERENCES

As far as is known, there are no pending appeals, interferences or judicial proceedings which may be related to, directly affect or be directly affected by or having a bearing on the Board's decision in the pending appeal.¹

¹ Application No. 10/832,339, a CIP of the instant application, was filed on April 27, 2004. So far no Office Action has been received for this case.

STATUS OF CLAIMS

Claims 1-2, 4-11, 13-21 and 23-28 are pending in this application.

Claims 3, 12 and 22 were canceled.

Dependent claims 7 and 26 are deemed allowable.

Claims 1-2, 4-6, 8-11, 13-21, 23-25 and 27-28 stand rejected under cited prior art and are hereby appealed.

Being appealed claims 1-2, 4-6, 8-11, 13-21, 23-25 and 27-28 (along with allowable claims 7 and 26) are reproduced in the Claims Appendix of this Brief.

STATUS OF AMENDMENTS

No amendment was filed in response to the receipt of the final rejection Office Action of August 24, 2007. An Appeal Brief dated January 16, 2008 was filed in response to the August 24, 2007 Office Action.

No amendment was filed in response to the Office action dated December 1, 2008 reopening the prosecution of this case.

No amendment has been filed in response to the Examiner's Answer dated July 7, 2009 with the "new" ground of rejection.

SUMMARY OF CLAIMED SUBJECT MATTER

The present invention is directed to a safety needle assembly that has its needle sheath attached to a collar that in turn is mounted about the hub of the needle assembly. To achieve this, the at issue safety needle assembly is made up of components that are quite different from those in the prior art. The major components of the instant invention are shown for example in Fig. 1. They include a hub 4, a collar 6 to which a housing 8 is pivotally attached, and a sheath 12.

Of the being appealed claims, claim 1, 11 and 20 are independent.

Claim 1 recites a safety apparatus that comprises a needle (4) having a proximal portion (18) and a distal portion (20), and a needle (22) extending from a distal end (24) of the needle hub (Figs. 1-5, 6, 7) [paragraph 0028]. The safety apparatus also comprises a collar (6) rotatably mounted directly onto the distal portion of the needle hub so that the collar is rotatable about the needle hub. There is a first engage mechanism (68) at the inner circumferential surface of the collar (Figs. 8 and 9) [0033-0034]. A housing (8) is pivotally connected to the collar [0035]. The safety apparatus further includes a needle sheath (12) having a proximal portion (74) with a second engage mechanism (90) at its outer circumferential surface (Fig. 12) [0038]. The first and second engage mechanisms (68, 90) of the collar and needle sheath, respectively, fit to each other when the sheath is fitted to the collar. The proximal portion (74) of the needle sheath has only one side in contact engagement to the collar for covering the needle extending from the distal end of the needle hub. The sheath is not in contact with the needle hub when it is fitted to the collar and the first and second engage mechanisms are engaged to each other (Figs. 4, 5) [0038].

Thus, as best shown in the cross-sectional view of Fig. 4, the safety apparatus of claim 1 has a mechanism 68 at its collar 6 that engages a corresponding mechanism 90 at the sheath 12, so that needle 22 is covered by the sheath 12, which in turn is only in contact with the inner surface of collar 6 and yet at the same time not in contact with extension 24 of the needle hub. Also, given that collar 6 is mounted directly about needle hub 4 (set forth in more detail in dependent claim 7), collar 6, along with sheath 12, is rotatable about needle hub 4.

Claim 11 is a combination claim that recites a needle hub (4) having a proximal portion (18) and a distal portion (20) that has a luer connector (40) at its proximal portion, and a ring (28) surrounding but in spaced relationship with the luer connector (Figs. 6, 7). There is at least one window (42) provided at the ring to enable the viewing of the luer connector, the ring being graspable by a user to remove the needle hub from the syringe. The distal portion of the needle hub has a distal end from which a needle extends [0029-0030]. There is further a collar (6) having a housing (8) pivotally connected thereto that directly fits to and rotatable about the distal portion of the needle hub [0032-0033]. The combination moreover includes a needle sheath (12) that has a proximal portion (74) with only one side in contact engagement to the collar, but not in contact with the needle hub. The needle sheath is removable from the collar to expose the needle for use (Figs. 1-10, 12) [0038].

The combination device of claim 11 therefore requires a collar to be fitted directly to and rotatable about the needle hub, and a needle sheath that is in contact engagement to the collar only and not in contact with the needle hub. In addition, the combination device requires a ring that surrounds but in spaced relationship with the luer connector of the needle hub, and at least one window provided at the ring to enable the viewing of the luer connector. By allowing the viewing of the luer connector, the user can readily see flashing of blood during a blood withdrawing procedure so as to determine whether the needle has been correctly inserted to the vein of a patient [0030].

Claim 20 is a method claim that is directed to the making of the needle assembly of the instant invention. The method comprises the step of providing a needle hub (4) having a proximal portion (18) and a distal portion (20) [0028], the step of providing a collar (6) with a housing (8) pivotally connected thereto, with the collar having a first engage mechanism (68) formed at its inner circumferential surface [0032-0033], the step of rotatably mounting the collar directly onto the distal portion (20) of the needle hub (4) so that the collar is rotatable about needle hub [0033], and the step of fitting a needle sheath (12) having a second engagement mechanism (90) at its circumferential outer surface to the collar, with the first and second engage mechanisms (68, 90) fitting to each other so that the sheath is removably engaged to the collar to cover the needle that extends from the needle hub, and yet with only one side of the proximal portion of the needle sheath being engaged to the collar without the needle sheath contacting the needle hub (Figs. 1-10, 12) [0038].

For the method claim, similar to the safety apparatus set forth in claim 1, the collar is mounted directly about the needle hub so as to be rotatable thereabout, and the needle sheath does not make any contact with the needle hub as only one side of the proximal portion of the needle sheath is engaged to the collar, for example the outer circumferential side per shown in Fig. 4.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

- I. Claims 1-2, 4, 9, 20-21, 23 and 28 stand rejected under 35 U.S.C. §103(a)² as being obvious over Crawford et al. (US 2002/0161336) in view of Hudon (US 7,156,825).
- II. Claims 8 and 27 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Crawford in view of Hudon and further in view of Landis (US 5,490,841).
- III. Claim 10 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Crawford in view of Hudon and further in view of Gyure (US 5,669,889).
- IV. Claims 5 and 24 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Crawford in view of Hudon and further in view of Johnson et al. (US 2002/0010433).
- V. Claims 6 and 25 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Crawford in view of Hudon and Johnson, and further in view of Pressly, Sr. et al. (US 7,014,622).³
- VI. Claims 11, 13-17 and 19 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Johnson in view of Crawford and Hudon and further in view of Pressly.
- VII. Claim 18 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Johnson in view of Crawford, Hudon, Pressly and Landis.

² It is believed that this rejection has been erroneously labeled as a 102(e) rejection in both the final rejection Office Action and the Examiner's Answer, when it should be a 103(a) rejection.

³ This is the "new" ground of rejection set forth in the Examiner's Answer.

ARGUMENT

Appellants respectfully request that the patentability of all claims discussed hereinbelow be adjudged separately.

I. **35 U.S.C. §103(a) rejection of Claims 1-2, 4, 9, 20-21, 23 and 28 as being obvious over Crawford et al. (US 2002/0161336) and Hudon (US 7,156,825)**

As discussed above in the Summary of the Claimed Subject Matter section, the instant invention relates to a safety needle device, and a method of making it, that has a collar rotatably mounted directly to a needle hub and a needle sheath that fits to the collar in such a way that it only contacts the collar but not the needle hub for protecting the needle that extends from the needle hub. The way in which the sheath is attached to the collar is by means of a first engage mechanism at the collar coacting with a second engage mechanism at the needle sheath.

Independent Claims 1 and 20

Among other limitations, independent apparatus Claim 1 recites a collar rotatably mounted directly on the distal portion of the needle hub so as to be rotatable about said needle hub, and independent method Claim 20 recites the step of rotatably mounting said collar directly on the distal portion of said needle hub so that said collar is rotatable about said needle hub. Claims 1 and 20 moreover each require that the first and second engage mechanisms at the collar and needle sheath, respectively, be fitted to each other when the sheath is fitted to the collar, and that only one side of the proximal portion of the sheath be in contact engagement with the collar (Claim 1), or that only one side of the proximal portion of the sheath be engaged to the collar (Claim 20).

Dependent Claims 4 and 23

Claim 4 depends from Claim 1 and Claim 23 depends from Claim 20. Each of these claims defines the second engage mechanism of the needle sheath to be a groove (90) formed circumferentially proximate to the open end of the needle sheath and the first engage mechanism of the collar to be a rib (68) circumferentially formed at the inner wall of the distal end of said collar, and that the needle sheath is attached to the collar when the rib mates with the groove (Fig. 4) [paragraph 0038].

Discussion

Crawford discloses a needle assembly that has a needle hub 60 for a double ended needle (42, 44). The needle hub 60 is fitted into a rear skirt portion 94 of a collar 90. A housing 140 is pivotally attached to the collar 90. A sleeve 50 is removably threaded into the forward skirt portion 92 of the collar. The collar 90 is fixedly attached to the needle hub 60 for the Crawford device. This is disclosed in paragraph [0064] of Crawford as follows:

The safety shield assembly and the needle assembly are assembled together whereby needle 40 is connected to hub 60 and sealed with adhesive at the ends of the hub. Hub 60 then is joined with collar 90 by *ultra-sonic welding techniques or any other bonding techniques, or mechanical fit*, whereby rearward annular skirt 94 of collar 90 mates with ribbed end 66 of the hub. Male ribs 82 of the hub are *contained or forced fitted* within inner sidewall 102 of rearward annular skirt 94 of collar 90. *Collar 90 is aligned with the intravenous end of needle 40 whereby the hook 114 is aligned with the bevel [tip] of needle 40.* External threads 96 adjacent proximal end 54 of first rigid sleeve 50 then are threaded into engagement with internal threads 97 formed on inner circumferential surface 96 of forward skirt 92 of collar 90 to cover needle 40.

Hudon discloses a combination sleeve and collar that is adapted to be retrofitted to a conventional needle hub. In particular, with reference to Fig. 1, Hudon discloses a sleeve 2 that has a distal portion 6 and a proximal portion 4. At distal portion 6 there is a groove 8 about which a collar 30 is fitted, per shown in the middle of Fig. 2, so that collar 30 is rotatable about sleeve 2. To retrofit the combination sleeve/collar to a conventional needle hub, such as 28, sleeve 2 is fitted over needle hub 28 so that the sleeve flange 24 at the end of the proximal portion 4 of sleeve 2 would overlay the needle hub flange 26 at the open end of needle hub 28. The needle cap 20 that shields needle 48 that extends from needle hub 28 is frictionally coupled to needle hub 28 by means of its base portion 60 (column 3, lines 21-25). Since base portion 60 of needle cap 20 has a diameter that is larger than the internal shoulder 16 (Fig. 1) formed at the intersection of the proximal portion 4 and the distal portion 6 of sleeve 2, sleeve 2 is held fixedly to needle hub 28 (column 3, lines 25-31). Thus, the retrofitted unit, i.e., the assembled sleeve/hub needle assembly designated 62 in Fig. 3, has its sleeve 2 fixedly held to needle hub 28, and its

collar 30 rotatably mounted about the groove 8 at the distal portion of sleeve 2 (column 3, lines 35-38).

The sleeve/hub needle assembly is retrofittedly used with a fluid collecting or dispensing container such as a syringe 64 that has a luer 66 having an internal helical groove 70 configured to accept the flange 26 of needle hub 28. As flange 24 of sleeve 2 overlies flange 26 of needle hub 28 and sleeve 2 is held fixed to needle hub 28 by needle cap 20, when needle hub 28 is threadedly mated to luer 66 of syringe 24, both flanges 26 and 24 are threaded along helical groove 70 into luer 66 so that the sleeve/hub needle assembly 62 is fixedly coupled to the luer 66 of the syringe 64 (column 3, lines 44-59). With both flanges 26 and 24 threadedly coupled to the luer of the syringe, the needle hub 28 and sleeve 2 are fixedly held to each other and also to the luer of the syringe, with the collar 30 being rotatable about the distal portion of sleeve 2, even after needle cap 20 has been removed from needle hub 28.

To support her rejection of the above-noted claims as being obvious over the combination of Crawford and Hudon, the examiner states: "Crawford et al disclose the invention except for the collar being rotatably mounted on the needle hub. Hudon disclose in Figure 3 that it is known to use a collar which is rotatably mounted on a needle hub. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Crawford et al with a rotatably mounted collar as taught by Hudon since such a modification would make it easier to connect the collar and hub." (1st full paragraph on page 3 of Office Action dated December 1, 2008)

Independent claims 1 and 20

The examiner has admitted that the collar in the Crawford device is not rotatably mounted about the needle hub. Indeed, that collar 90 be fixedly attached to hub 60 for the Crawford device is a must since if collar 90 were rotatable about needle hub 60, then a user would not be able to thread sleeve 50 into collar 90, as collar 90 would rotate as sleeve 50 is turned. Such fixed attachment of collar 90 to needle hub 60 is moreover an essential feature of the Crawford device, since the shield 140, which is hingedly attached to collar 90 by means of hook 115, has to be rotated relative to the collar 90 such that the bevel tip 46 of needle 44 that extends from needle hub 60 be at a given orientation. See Fig. 2 (overall view of the components), Fig. 4 (collar 90), Fig. 5 (hub 60 with the double

ended needle 42, 44), and Fig. 10 (cross sectional view of hub 60 fitted into collar 90) of Crawford.

The examiner asserts that "Hudon disclose in Figure 3 that it is known to use a collar which is rotatably mounted on a needle hub."

As explained above, Hudon does not disclose "a collar which is rotatably mounted on a needle hub", per assertion made by the examiner. In fact, Hudon does not even disclose its collar being "mounted directly on the distal portion of said needle hub", as required in claims 1 and 20. As explained above, for the Hudon sleeve/hub needle assembly 62, before mating to a syringe or other fluid storage device, the sleeve 2 is held fixedly to needle hub 28 by the friction fitting of needle cap 20 to the needle hub 28. This results from base 60 of needle cap 20 pressing against internal shoulder 16 of sleeve 2. And once the sleeve/hub needle assembly is mated to a syringe, due to the threading of the respective flanges 26 and 24 to the helical groove 70, sleeve 2 continues to be fixedly held to needle hub 28, even after needle cap 20 is removed. Thus, collar 30 is rotatable about the distal portion of sleeve 2, not needle hub 28. Therefore, it is submitted that Hudon does not teach and fails to suggest that the collar of his device be mounted directly on the needle hub. It is therefore respectfully submitted that the examiner has misconstrued the teachings of Hudon.

The examiner further asserts that "it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Crawford et al. with a rotatably mounted collar as taught by Hudon since such a modification would make it easier to connect a collar and hub."

Appellants respectfully submit that the reasoning provided by the examiner does not make sense in view of the following. First, as noted above, it is incumbent for the Crawford device that its collar 90 be fixedly attached (by either ultra-sonic welding or bonding, or friction fit) to needle hub 60. Otherwise needle sheath 50 could not be threaded to the forward annular skirt 92 of collar 90, as collar 90 would not stay still for sleeve 50 to be threaded thereinto. Thus, if the Crawford device were to be modified per the assertion by the examiner, i.e., that collar 90 be rotatably mounted about needle hub 60, such modification would render the Crawford device unusable. Second, simply put, Hudon does not teach what the examiner asserts that it teaches. In other words, Hudon does not teach

that its collar 30 be mounted "directly to the needle hub", as required in claims 1 and 20. At best, Hudon teaches that collar 30 is rotatably mounted to a distal portion 8 of sleeve 2, which is not the same as having sleeve 30 mounted directly to needle hub 28. Indeed, Hudon teaches that his needle cap 20 is frictionally held to needle hub 28 (column 3, lines 21-25), so that sleeve 2 of the sleeve/hub needle assembly 62, when placed over needle hub 28, be "held fixedly by the needle hub 28 coupled with needle cap 20" (column 3, lines 30-31). Thus, even if the sleeve/hub needle assembly of Hudon were to be substituted for collar 90 of the Crawford device, sleeve 2 nonetheless would continue to rotate about needle hub 60, as there is nothing to hold it fixedly to the needle hub 60 of the Crawford device. Moreover, such substitution would run counter to the limitations recited in claims 1 and 20 that require that only one side of the proximal portion of the sheath be in contact engagement with the collar or be engaged to the collar. Any attempt to fixedly hold the sleeve 2 of Hudon to the needle hub 60 of Crawford would require that a needle cap or sheath be in friction contact with the needle hub 60 of Crawford, as Hudon clearly teaches that his needle cap 20 be friction fitted to the needle hub 28, not sleeve 2.

In the Examiner's Answer, the Examiner argues that the test for obviousness is what the combined teachings (i.e., Crawford and Hudon) would have suggested to those of ordinary skill in the art (p. 11, ll. 4-6 of Examiner's Answer).

Yet as discussed above, the respective disclosures of Crawford and Hudon actually teach away from each other, which is an indication that there is no obviousness.

Simply put, the combination of Crawford and Hudon as asserted by the examiner not only renders the combined device not useable but also runs counter to the respective teachings of Crawford and Hudon. Appellants therefore respectfully submit that independent claims 1 and 20 each are non-obvious over the combination of Crawford and Hudon.

Dependent claims 4 and 23

For the rejection of claims 4 and 23, the examiner asserts that the claimed second engage mechanism is met by the internal threads 56 at collar 90 and that the claimed first engage mechanism is met by the external threads 56 at needle sheath 50. [Last sentence on page 2 of the December 1, 2008 Office Action.]

Claims 4 and 23 each define “the second engage mechanism” to be a groove formed circumferentially at the open end of the needle sheath and “the first engage mechanism” to be a rib formed circumferentially at the inner wall of the distal end of the collar.

Crawford shows helical thread 56 and counter helical groove 97 along corresponding portions of the sheath and collar, respectively. Assuming an objective person or a person skilled in the art is not unreasonably stretching his or her imagination, to such person, even by resort to a broadest reasonable interpretation, it is submitted that a circumferential groove formed at the open end of the sheath and a circumferential rib formed at the inner wall at the distal end of the collar are not the same as the helical thread 97 that is formed throughout the forward skirt 92 of collar 90 and the counterbore helical groove 56 that is formed all along the proximal end 54 of sleeve 50, per shown in Figs. 2 of Crawford.⁴ By definition, the helical thread and its corresponding groove are mated by turning whereas a circumferential groove and its corresponding circumferential rib could only be mated by being snapped together, per taught in the disclosure of the instant application. Simply put, the threading connection of a threaded screw to a helical groove is not the same as the coupling of a circumferential groove with a circumferential rib.

In view of the above, it is submitted that Crawford fails to disclose or suggest the claimed first and second engage mechanisms recited in claims 2 and 23. Appellants therefore submit that the obvious rejection of independent Claims 1 and 20 and dependent Claims 4 and 23 under Crawford and Hudon is without merit and not sustainable.

II. §103 rejection of dependent Claims 8 and 27 over the combination of Crawford, Hudon and Landis (US 5,490,841)

⁴ The Examiner argues that it is her position “that under the broadest reasonable interpretation the helical thread and corresponding groove of Crawford meet the limitation of a rib (the raised portion of the thread) and a circumferential groove (the area between the threads).” [Examiner’s Answer, P.10, II.17-20]

For the §103 rejection of Claim 8 and Claim 27 over the combination of Crawford and Landis (US 5,490,841), it is respectfully submitted that Landis fails to teach lips being angled toward the interior of housing with the respective angles of said lips being varied along the length of said housing to effect guide for said needle to smoothly enter into said housing at an angle through said opening, as required in claims 8 and 27. Such can readily be seen by comparing the angled slot opening 88 shown in Fig. 10 of the instant application with Figs. 6-12 of the protective housing shown in Landis.

Claims 8 and 27 are therefore submitted to be patentable over the cited prior art.

III. §103 rejection of Claim 10 over Crawford, Hudon and Gyure et al, (US 5,669,889)

Appellants submit that Claim 10 stands or falls with independent Claim 1 from which it indirectly depends.

IV. §103 rejection of dependent Claims 5 and 24 over Crawford, Hudon and Johnson et al. (US 2002/0010433)

Claim 5 depends from independent Claim 1, while Claim 24 depends from independent Claim 20. Each of Claims 5 and 24 defines the needle hub (4) to have a luer end (40) at its proximal portion and a user graspable ring (28) surrounding and in spaced relationship with the needle hub, with the ring being integral of the needle hub via a distal end wall (30) extending transversely from the needle hub (Figs. 6 and 7) [0029-0030].

In *KSR International Co. v. Teleflex Inc.*, 127 S Ct.1727, 1737 (2007), the Court holds that “the combination of familiar elements according to known methods is likely to be obvious when it does no more yield predictable results.” The court further holds that whether an improvement is obvious depends on “the predictable use of prior art elements according to the established functions.”

In light of the Court's mandate, it is believed that the question that should be addressed by the Board in determining whether the instant invention, as set forth in Claims 5 and 24, is patentable over the combination of Crawford, Hudon and Johnson is to look at whether or not the claimed invention, to a person skilled in the art, would have been predictably resulted from the Crawford/Hudon/Johnson combination.

Appellants respectfully submit that the combination of Crawford, Hudon and Johnson, assume feasible for the sake of argument, would produce a result that has no bearing to the claimed subject matter per the following.

Johnson discloses an adapter 40 for a "LUER LOK" receptacle to prevent crack and break at the intersection of the hub with a syringe barrel (Fig. 1C and paragraph 0008 of Johnson]. The Johnson adapter has a housing 42 that surrounds the male end 70 of a fitting 44 of a catheter 46 (Fig. 2C), so that a recess 50 is formed between housing 42 and male connector end 70. In operation, the adapter 70 is press fitted to a hub 18 that extends from the barrel 14 of a syringe [paragraph 0004] to form a "rigidifying seal" to prevent the hub 18 from spreading, to thereby decrease the likelihood that receptacle 12 of the syringe would break or crack, and to provide a fluid tight seal to prevent fluid or vacuum leak from the syringe/adapter junction [Fig. 2D, paragraphs 0011 and 0044].

Thus, the hub that is disclosed in Johnson is a syringe hub to which, at best, a needle assembly may be mated. It is not the needle hub to which a needle assembly is mated per required in the claims of the instant invention. Further, that Johnson discloses the syringe hub to be press fitted to his adapter for "rigidifying" the syringe hub [paragraph 38] makes it clear that the Johnson adapter is not rotatably mounted onto the syringe hub. That being the case and given the above discussion with respect to Crawford and Hudon, there is no conceivable way in which the instant invention, which requires that the ring be integral of the needle hub via a distal end wall that extends from the needle hub, could predictably result from the combined teachings of

Crawford, Hudon and Johnson, per asserted by the examiner. The claimed ring simply is not taught or suggested by any of Johnson, Crawford and Hudon.⁵

Appellants therefore submit that the rejection of Claims 5 and 24 under the combination of Crawford, Hudon and Johnson is without merit and not sustainable.

V. §103 rejection of dependent Claims 6 and 25 over Crawford, Hudon, Johnson and Pressly, Sr et al. (US 7,014,622)⁶

Claims 6 and 25 depend from Claims 5 and 24, respectively.

In support of this rejection, the examiner asserts that Pressly "teaches the use of a window as a transparent ring on a needle assembly for viewing a joint of a needle hub, see figure 10 and col. 7 lines 35-43, wherein the transparency would be deemed a window." (2nd full paragraph on page 4 of the December 1, 2008 Office Action)

In addition to the discussion in Section IV above showing that Crawford, Hudon and Johnson cannot be combined as asserted by the examiner, and therefore by that alone the rejection of Claims 6 and 25 cannot stand, Appellants further submit that Pressly does not disclose any window "transparent ring." Rather, as shown in Fig. 10 and the isolated sectional view of the guard edge of the needle guard in Fig. 10A, Pressly discloses a transparent needle assembly 8 that is to be fitted to the syringe

⁵ In the Examiner's Answer, the only rebuttal to the above argument by the Examiner is the following: "Examiner points to Figure 2F and paragraph [0042] where Johnson discloses the adapter assembly being used with medical instruments such as needle hubs." [Examiner's Answer, p. 12, ll. 11-15.]

It is submitted that paragraph [0042] may have been misconstrued by the Examiner, as it fails to support the Examiner's contention that Johnson, Crawford and Hudon may be combined per asserted.

⁶ In the Appeal Brief filed on February 27, 2009, Appellants had made of record that the examiner had failed to properly reject Claims 6 and 25 insofar as those claims respectively depend from dependent Claims 5 and 24, which stand rejected under Crawford, Hudon and Johnson. Appellants further noted that the proper rejection for Claims 6 and 25 should have been Crawford in combination with Hudon and Johnson and further in view of Pressly. The argument against the rejection accordingly addressed the rejection based on the combination of Crawford, Hudon, Johnson and Pressley.

barrel 6 for enclosing the needle hub 2 during the manufacturing process of the Pressly device. See Fig. 1 for the cross sectional view of the assembled Pressly safety syringe. With the needle assembly 8 being transparent, the user can see the joining of the head 12 of the needle 14 to the needle hub 2 (col. 7, lines 35-47).

Thus, in contrast to the assertion by the examiner, the Pressly needle assembly 8, be it transparent or otherwise, is not a ring that is in spaced relationship with a luer connector. There in fact is no luer connector disclosed in Pressly, for the Pressly device is a syringe with a specially designed needle hub that is adapted to have different types of needles connected thereto (column 5, lines 29-35). Indeed, Pressly discloses that needle assembly 8 is permanently joined to syringe barrel 6 (column 5, lines 59-63). Thus, to assert that the syringe of Pressly may be combined with the double-ended needle of Crawford, the retrofitted sleeve/hub needle assembly of Hudon, and further the adapter for a luer lock as disclosed in Johnson does not make any sense, let alone providing the predictable result required for a valid obviousness rejection per mandated by the KSR holding noted above.⁷

Appellants therefore submit that the rejection of Claims 6 and 25 is without merit and not sustainable.

VI. §103 rejection of Claims 11, 13-17 and 19 over Johnson, Crawford, Hudon and Pressly

Independent Claim 11

Claim 11 sets forth a combination comprising a needle hub that has a luer connector at its proximal portion and a ring surrounding but in spaced relationship with the luer connector. At least one window is provided at the ring to enable viewing of the luer connector. A collar having a housing pivotally connected thereto is rotatably fitted about the distal portion of said needle hub. A needle sheath is fitted to the collar but with only one side in contact engagement to said collar.

⁷ Appellants do not understand the rebuttal by the examiner to Appellants' argument for this rejection. See Examiner's Answer, p.12, l.16 to p.13, l.5.

This rejection is based on the same prior art applied against Claims 5 and 24 in Section IV above. Accordingly, the same argument set forth in Section IV for patentability is equally applicable herein. In addition, given that the “window” feature in the ring is recited in Claims 6 and 25 and discussed in Section V above, the argument in Section V relating to Crawford and Johnson is likewise applicable herein.

In brief, Johnson, Crawford, Hudon and Pressly each fail to disclose a “window” at a “ring” that spatially surrounds a luer end.

Moreover, Crawford discloses a needle hub 60 that is fixed to a collar 90. The sleeve 2 of Hudon is held fixedly to the needle hub 28. The crux of the Johnson invention is the forming of a rigidifying seal to support the outside diameter of hub 18 so as to prevent hub 18 from spreading and/or from cracking or breaking, and also allow the user to “manipulate more aggressively” the device. In addition, the housing 42 provides a fluid tight seal to prevent fluid from leaking [paragraph 0044]. That housing 42 forms a rigidified seal clearly means that Johnson does not intend to have any “window” or openings provided at housing 42. Otherwise, the purpose of the Johnson adapter being a rigidifying seal would be totally defeated, because a “window” would de-rigidify hub 18 at best and, at worst would also allow fluid to escape from the adapter in contrast to the stated “prevent fluid from leaking” objective of Johnson.

The combination of Johnson, Crawford, Hudon and Pressly therefore does not pass muster under the predictable result analysis mandated by the KSR decision for validation of an obviousness rejection. If anything, the cited prior art references actually teach away from each other.

The rejection of Claim 11 is therefore submitted to be without merit and not sustainable.

Dependent Claims 13-17 and 19

Claim 13 depends from Claim 11 and defines the needle sheath (12) to have a first engage mechanism (90) proximate to its open end and the collar (4) to have a second engage mechanism (68) at its distal portion (Figs. 1-10 and 12) [paragraph 0038].

Claim 14 depends from Claim 11 and defines the needle sheath (12) to have a circumferential groove (90) proximate to its open end and the collar (4) to have a second engage mechanism (68) at its distal portion.

To rebut the rejection of Claims 13 and 14, the same argument set forth above in Section I for Claims 4 and 23 is equally applicable herein.

Claim 15 depends from Claim 11 and defines the ring to include at least one window (92) on its sidewall to enable viewing of the luer connector and the proximal portion of the needle hub [0035].

There is no disclosure or suggestion in any of Johnson, Crawford, Hudon and Pressly of a window formed at the side wall of the ring that enables the viewing of both the luer connector and the proximal portion of the needle hub.

Claim 17 depends from Claim 11 and defines the needle hub to include a plurality of flanges (44) extending from its distal portion that are located a predetermined distance from a wall (30) projecting orthogonally from said needle hub (4), so as to define a space (52) between the flanges and the wall circumferentially about the needle hub (Fig. 7) [0031]. The collar is defined to include a plurality of protrusions (62) at the inner wall of its proximal portion (58), with the protrusions dimensioned to fit to the space when the collar is mated to the needle hub, so that the collar is rotatable about said needle hub (Figs. 3-5) [0033].

Given that Claims 7 and 26 are deemed to contain allowable subject matter and Claim 17 covers similar subject matter, Appellants submit that Claim 17 should likewise be allowed. Johnson, Crawford, Hudon and Johnson, either singly or in combination, simply fail to disclose or suggest the subject matter recited in Claim 17.

VII. §103 rejection of dependent Claim 18 over Johnson, Crawford, Hudon, Pressly and Landis

Claim 18 recites similar subject matter as Claims 8 and 27. Accordingly, the same argument set forth above in Section II relating to Claims 8 and 27 is equally applicable herein.

Conclusion

In view of the forgoing, Appellants submit that the rejections of the above-discussed claims are without merit and not sustainable. The Board is therefore respectfully requested to reverse the examiner's rejections.

Respectfully submitted,



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CLAIMS APPENDIX

1. Safety apparatus, comprising:
 - a needle hub having a proximal portion and a distal portion, a needle extending from a distal end of said needle hub;
 - a collar rotatably mounted directly on the distal portion of said needle hub so as to be rotatable about said needle hub, said collar having a first engage mechanism at its inner circumferential surface;
 - a housing pivotally connected to said collar; and
 - a needle sheath having a proximal portion with a second engage mechanism at its outer circumferential surface, said first and second engage mechanisms fitted to each other when said sheath is fitted to said collar, said proximal portion having only one side in contact engagement to said collar for covering said needle extending from the distal end of said needle hub and said sheath is not in contact with said needle hub when said sheath is fitted to said collar and said first and second engage mechanisms are engaged to each other.
2. Safety apparatus of claim 1, wherein after said needle sheath is removed from said collar, said housing is pivotable to a position substantially in alignment along a longitudinal axis of said needle hub for covering said needle.
3. (Cancel)
4. Safety apparatus of claim 1, wherein said second engage mechanism of said needle sheath comprises a groove formed circumferentially proximate to the open end of said needle sheath and wherein said first engage mechanism of said collar comprises a rib circumferentially formed at the inner wall of the distal end of said collar; and
 - wherein said needle sheath is attached to said collar when said rib of said collar mates with said groove after said needle sheath is positioned over said needle and engages said collar.
5. Safety apparatus of claim 1, wherein said needle hub comprises a luer end at its proximal portion, a ring surrounding and spaced from said luer end, said ring being integral of said needle hub via a distal end wall extending transversely therefrom; and
 - wherein a user can readily grasp said ring to couple said safety device to a medical device by threadingly mating said luer end of said needle hub to a counterpart luer end at said medical device.
6. Safety apparatus of claim 5, wherein said ring comprises at least one window to enable the user to view said luer end of said needle hub and said needle hub.

7. (Allowable) Safety apparatus of claim 1, wherein said needle hub comprises at least one flange extending from its distal portion, said flange being located a predetermined distance from a wall projecting orthogonally from said needle hub, a space being formed between said flange and said wall circumferentially about said needle hub; and

wherein said collar comprises at least one protrusion at the inner wall of its proximal portion, said protrusion being dimensioned to fit to said space defined between said flange and said wall when said collar is mated to said needle hub, said collar rotatable about said needle hub after matingly fitted to said space.

8. Safety apparatus of claim 1, wherein said housing comprises a longitudinal opening formed by first and second lips each extending along substantially the length of said housing, said first lip overlapping a portion of said second lip with said opening being off centered from said longitudinal axis, each of said lips being angled toward the interior of said housing with the respective angles of said lips being varied along the length of said housing to effect a guide for said needle to smoothly enter into said housing at an angle through said opening when said housing is pivoted to cover said needle, said needle not removable from said housing once said needle fully enters into said housing.

9. Safety apparatus of claim 1, wherein said collar has formed proximate to its distal end one lock mechanism and wherein said housing has formed at its proximal end an other lock mechanism, said one and other lock mechanisms coacting to fixedly retain said housing to said collar once said housing is pivoted to a position in substantial alignment with said needle hub to cover said needle.

10. Safety apparatus of claim 9, wherein said one lock mechanism comprises at least one one way catch member extending from the outer surface of said collar or said housing, and said other lock mechanism comprises at least one corresponding aperture at said housing or said collar, said one way catch member matingly coupled to said aperture for fixedly retaining said housing to said collar when said housing is pivoted to cover said needle.

11. In combination, a needle hub having a proximal portion and a distal portion, said proximal portion having a luer connector and a ring surrounding but in spaced relationship with said luer connector, at least one window provided at said ring to enable viewing of said luer connector, said ring being graspable by a user to remove said needle hub from a syringe, said distal portion of said needle hub having a distal end from which a needle extends, a collar having a housing pivotally connected thereto directly fitted to and rotatable about said distal portion of said needle hub, and a needle sheath having a proximal portion with only one side in contact engagement to said

collar, said needle sheath not in contact with said needle hub and removable from said collar to expose said needle for use.

12. (Canceled)

13. Combination of claim 11, wherein said needle sheath comprises a first engage mechanism proximate to its open end and wherein said collar comprises a second engage mechanism at its distal portion, said first engage mechanism engages said second engage mechanism for attaching said needle sheath to said collar when said needle sheath is positioned over said needle and mates with said collar.

14. Combination of claim 11, wherein said needle sheath comprises a circumferential groove proximate to its open end and said collar comprises a circumferential rib at its distal portion, said rib mating to said groove when said needle sheath is positioned over said needle and fitted to said collar.

15. Combination of claim 11, wherein said ring comprises at least one window on its sidewall to enable viewing of said luer connector and said proximal portion of said needle hub.

16. Combination of claim 11, wherein said ring is adaptable to be used by a user to grasp said needle hub for connecting said luer connector to a corresponding luer connector of a medical device.

17. Combination of claim 11, wherein said needle hub comprises a plurality of flanges extending from its distal portion, said flanges being located a predetermined distance from a wall projecting orthogonally from said needle hub, a space being defined between said flanges and said wall circumferentially about said needle hub, and wherein said collar comprises a plurality of protrusions at the inner wall of its proximal portion, said protrusions being dimensioned to fit to said space when said collar is mated to said needle hub, said collar rotatable about said needle hub after matingly fitted to said space.

18. Combination of claim 11, wherein said housing comprises a longitudinal opening formed by first and second lips each extending along substantially the length of said housing, said first lip overlapping a portion of said second lip with said opening being off centered from said longitudinal axis, each of said lips being angled toward the interior of said housing with the respective angles of said lips being varied along the length of said housing to effect a guide for said needle to smoothly enter into said housing at an angle through said opening when said housing is pivoted to cover said needle, said needle not removable from said housing once said needle fully enters into said housing.

19. Combination of claim 11, wherein said collar has formed proximate to its distal end a first lock mechanism and wherein said housing has formed at its proximal end a second lock mechanism, said first and second lock mechanisms coacting to fixedly retain said housing to said collar once said housing is pivoted to a position in substantial alignment with said needle hub to cover said needle.
20. A method of making a needle assembly, comprising the steps of:
- a) providing a needle hub having a proximal portion and a distal portion;
 - b) fixedly attaching a needle to a distal end of said needle hub;
 - c) pivotally connecting a housing to a collar having a first engage mechanism formed at its inner circumferential surface;
 - d) rotatably mounting said collar directly on the distal portion of said needle hub so that said collar is rotatable about said needle hub; and
 - e) fitting a needle sheath having a second engagement mechanism at its circumferential outer surface to said collar, said first and second engage mechanisms fitting to each other so that said sheath is removably engaged to said collar and only one side of a proximal portion of said needle sheath is engaged to said collar without said needle sheath contacting said needle hub for covering said needle extending from the distal end of said needle hub.
21. Method of claim 20, further comprising the steps of:
- removing said needle sheath from said collar before using said needle; and
 - pivoting said housing to a position substantially in alignment along a longitudinal axis of said needle hub for covering said needle.
22. (Canceled)
23. Method of claim 20, wherein said second engage mechanism comprises a circumferential groove formed proximate to an open end of said needle sheath, and wherein said first engage mechanism comprises a rib formed circumferentially at the inner wall of a distal portion of said collar; and
- wherein said step e comprises the steps of:
 - positioning said needle sheath over said needle; and
 - engaging said needle sheath to said collar until said rib of said collar mates with said groove of said needle sheath.
24. Method of claim 20, wherein said step a comprises the steps of:
- forming a luer end at the proximal portion of said needle hub; and
 - forming a ring in spaced relation to surround said luer end, said ring being integral of said needle hub via a distal end wall;

wherein a user can readily grasp said ring to couple said needle assembly to a medical device by mating said luer end of said needle hub to a counterpart luer end at said medical device.

25. Method of claim 24, wherein said forming a ring step further comprises the step of:

forming at least one window on said ring to enable the user to view said luer end of said needle hub and said needle hub.

26. (Allowable) Method of claim 20, wherein said step a comprises the steps of: providing at least one flange extending from said distal portion of said needle hub; and

locating said flange a predetermined distance from a wall projecting orthogonally from said needle hub to define a space between said flange and said wall circumferentially about said needle hub;

wherein the method further comprising the steps of:

forming at least one protrusion at the inner wall of said collar;

dimensioning said protrusion to fit to said space defined between said flange and said wall; and

mating said collar to said needle hub, said collar rotatable about said needle hub after being mated to said space.

27. Method of claim 20, further comprising the step of:

providing a longitudinal opening along said housing by forming first and second lips each extending along substantially the length of said housing, said first lip overlapping a portion of said second lip with said opening being off centered from said longitudinal axis, each of said lips being angled toward the interior of said housing with the respective angles of said lips being varied along the length of said housing to effect a guide for said needle to smoothly enter into said housing at an angle through said opening when said housing is pivoted to cover said needle, said needle not removable from said housing once said needle fully enters into said housing.

28. Method of claim 20, further comprising the steps of:

forming a first lock mechanism proximate to the distal end of said collar; and

forming a second lock mechanism at a proximal end of said housing;

wherein said first and second lock mechanisms coact to fixedly retain said housing to said collar once said housing is pivoted to a position in substantial alignment with said needle hub to cover said needle.

EVIDENCE APPENDIX

None.

RELATED PROCEEDINGS APPENDIX

None.